

APR 17 2006



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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>YOR920000552US1</b>	
I hereby certify that this correspondence is being transmitted by facsimile transmission to: Examiner Naeem U. Haq, Art Unit 3625, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No. 571-273-8300, on April 17, 2006.  Rosalind Q. Spiller		Application Number <b>09/752,330</b>	Filed <b>12/29/2000</b>
		First Named Inventor <b>Ravindra R. Mantena</b>	
		Art Unit <b>3625</b>	Examiner <b>Haq, Naeem U.</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>36,650</b>		 Signature <b>Wayne F. Reinke</b> Typed or printed name <b>518-452-5600</b> Telephone number <b>April 17, 2006</b> Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <b>1</b> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mantena et al. Confirmation No.: 8671  
Serial No.: 09/752,330 Group Art Unit: 3625  
Filed: 12/29/2000 Examiner: Haq, Naeem U.  
Title: METHOD, SYSTEM AND PROGRAM PRODUCT FOR PROVIDING FOR AN  
ENTITLED PRICE IN AN ELECTRONIC TRANSACTION

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by  
facsimile transmission to: Examiner Naeem U. Haq, Group Art Unit  
3625, United States Patent and Trademark Office, Alexandria, VA  
22313-1450, Facsimile No. 571-273-8300, on April 17, 2006.

  
Rosalind Q. Spiller

Date of Signature: April 17, 2006.

To: Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF PRE-APPEAL REQUEST**

Dear Sir:

In response to a final Office Action with a mailing date of January 17, 2006, response to which is due by April 17, 2006 without extension, which is therefore being timely filed, and in light of the accompanying Pre-Appeal Brief Request for Review and Notice of Appeal and payment therefor, kindly consider the following remarks.

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REMARKS

Claims 1-36 were originally presented in the subject application. Claims 1, 13 and 25 were amended in an Amendment and Response to Office Action dated June 4, 2004. Claims 37-48 were added in an Amendment and Response to Final Office Action dated November 5, 2004. Claims 1, 13, 25 and 37 were amended in an Amendment dated October 27, 2005. No claims have herein been amended, added or canceled. Therefore, claims 1-48 remain in this case.

Applicants respectfully request reconsideration and withdrawal of the various grounds of rejection.

Double Patenting

The final Office Action maintained the provisional rejection of claims 1-48 under the judicially created doctrine of obviousness-type double patenting, as allegedly unpatentable over claims 1-45 of co-pending U.S. Patent Application Serial No. 09/751,078 (US 2002/0087477 A1).

The cited U.S. patent application issued as U.S. Patent No. 6,999,949 on February 14, 2006 with claims 1-48 (hereinafter, "the '949 Patent").

The final Office Action alleges that the differences between the present claims and those of the '949 Patent amount to non-functional descriptive material, citing *In re Gulack* and *In re Lowry*. However, *In re Gulack* is a printed matter case and inapplicable outside that area, as confirmed by *In re Lowry*. In addition, *In re Lowry* concerns a data structure, which is not present in this case. Thus, Applicants submit that *In re Lowry* is inapplicable as well. Applicants submit the final Office Action allegation amounts to improperly ignoring claim limitations.

Moreover, Applicants submit that the present claims are not obvious over the issued claims of the '949 Patent. For example, the present claims recite a request for an entitled price, whereas the '949 Patent recites a sales order. One is merely an inquiry, while the other is an order. As another example, the present application recites obtaining the entitled price in real time, whereas the '949 Patent does not.

35 U.S.C. §112 Rejection

The Office Action rejected claims 1-48 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject invention. Specifically, the final Office Action alleged that it is unclear what the limitation "preexisting entitlement" means. Applicants respectfully, but most strenuously, traverse this rejection for the reasons detailed below.

On page 2 of the present application, at lines 12-16, the definition of "entitled price" is given as:

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Such negotiated prices are referred to herein as the "entitled price," which is the price a buyer is entitled to for a given item based on an entitlement, such as, for example, a contract with the seller or a promotional offer from the seller (e.g., a coupon) or a program with a business partner of the seller (e.g., "point" programs similar to airline mileage programs).

In addition, page 8, lines 21-23 of the application provides a further example of a discount contract.

Consistent with the definition for "entitled price" given in the present application, Webster's Ninth New Collegiate Dictionary defines "entitlement," in relevant part, as "a right to benefits specified esp. by law or contract." In two of the examples given, the entitlement is created by some sort of agreement with the seller, a contract being the easiest example. In the case of an offer (e.g., a coupon), acceptance creates an agreement, for example, presenting a coupon. Coupled with "preexisting," then, the term "preexisting entitlement" simply means a previously existing right, in this case, a right to an entitled price through agreement.

Therefore, Applicants submit that the meaning of "preexisting entitlement" is sufficiently clear from the specification.

#### 35 U.S.C. §103 Rejection

The Office Action rejected claims 1-3, 9-11, 13-15, 21-23, 25-27, 33-35, 37-39 and 45-47 under 35 U.S.C. §103, as allegedly obvious over Lidow (U.S. Patent No. 6,889,197). Applicants respectfully, but most strenuously, traverse this rejection.

Applicants expressly maintain their right to subsequently challenge the proper citation of Lidow against the present application, because it is unclear whether the Lidow claim back to U.S. Provisional Application Serial No. 60/175,868 is even proper. This priority claim appears to be the only basis upon which Lidow could be cited, since it is the only date in the chain that predates the filing date of the present application.

Claim 1 recites a method of providing an entitled price in an electronic transaction. The method comprises electronically sending by a requestor a request for an entitled price based on a preexisting entitlement from a public electronic environment, automatically routing the request to a private electronic environment, obtaining the entitled price within the private electronic environment in real time while the requestor waits, and automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

Against the aspect of obtaining the entitled price within the private electronic environment in real time while the requestor waits, the final Office Action first cites to Lidow at column 23, line

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64 to column 24, line 7, and FIG. 17, reference numerals 74 and 266. However, this first cited section of Lidow describes what costs go into the eventually calculated price. As shown in FIG. 17 and described at column 23, lines 43-46, pricing is calculated after delivery to the customer. Thus, Applicants submit that the price is not obtained in real time while the customer waits.

The final Office Action also cites to Lidow at FIG. 24, reference numeral 74, and column 27, lines 43-55. This second cited section of Lidow describes the ERP system in general terms, and indicates that employees of the server (i.e., employees of the company accessing the server) have real-time access to enterprise information. However, there is no teaching therein regarding access from outside the company. Applicants submit that obtaining an entitled price in real time for a waiting requestor based in a public electronic environment, i.e., external access, is simply different from internal company access by employees in real time.

With regard to the claimed "entitled price," the Office Action admits that "Lidow does not teach that the information requested is an entitled price." See the final Office Action at page 5. Nonetheless, the final Office Action alleges that the entitled price is "nonfunctional descriptive material," citing *In re Gulack* and *In re Lowry*.

As stated previously and confirmed by *In re Lowry*, the citation of *In re Gulack* is misplaced, since that is a printed matter case. However, the final Office Action continues to cite *In re Lowry*. Applicants submit that *In re Lowry* involves a data structure, which the present invention does not involve. As such, Applicants submit it is distinguishable on that point alone. Moreover, Applicants respectfully point out they are not claiming requesting, obtaining and returning just any information, but specifically an entitled price. The steps are all centered around this specific data. The invention is not, as alleged in the final Office Action, the sending, routing, obtaining and returning, but only when the information sought is an entitled price. Indeed, as set forth in the background, getting such information from private to public electronic environments on request is the problem sought to be solved. As such, Applicants submit it is not nonfunctional descriptive material.

Therefore, since Lidow fails to teach or suggest at least (1) obtaining the entitled price within a private electronic environment in real time for a waiting requestor in a public electronic environment, and (2) an entitled price, Applicants submit that claim 1 cannot be rendered obvious over Lidow.

Claims 13, 25 and 37 contain limitations similar to those noted above with respect to claim 1. Thus, Applicants submit the remarks made above regarding claim 1 are equally applicable

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to those claims. Therefore, Applicants submit none of claims 13, 25 or 37 can be made obvious over Lidow.

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 10 recites, among other things, messaging middleware causing a command to be issued to the ERP application. As best Applicants can tell, the final Office Action does not directly address claim 10. However, against the recitation of messaging middleware generally, the final Office Action cites to Lidow at column 27, lines 56-67. This section, however, fails to teach anything regarding the messaging services section issuing a command to any component of the system, let alone specifically to the ERP application.

Therefore, Applicants submit that claim 10 cannot be rendered obvious over Lidow.

Claims 22, 34 and 46 contain limitations similar to that noted above with respect to claim 10. Thus, Applicants submit the remarks made above regarding claim 10 are equally applicable to those claims. Therefore, Applicants submit none of claims 22, 34 or 46 can be made obvious over Lidow.

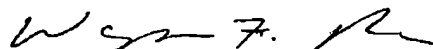
#### CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-48.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

  
Wayne F. Reinke  
Attorney for Applicants  
Registration No.: 36,650

Dated: April 17, 2006.

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